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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 965,826	10 01 2001	Hiroto Higuchi	213812US0	3984

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

GOODROW, JOHN L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 05 01 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-19

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on _____

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1- 36 is/are pending in the application.

Of the above claim(s) 32-36 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

☒ Claim(s) 1- 21 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All Some* None of the CERTIFIED copies of the priority documents have been received.

Certified copies not received

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s).

☒ Notice of References Cited, PTO-892

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

3, 9, 11-15, 17 & 18
Interview Summary, PTO-413

Notice of Informal Patent Application, PTO-151

Other _____

Office Action Summary

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1. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119(a)-(d), which papers have been placed of record in the file.

2. Numerous other cited portions of claims and drawings of applications and patents are also directed to electrophotographic methods and apparatus that do not appear material to the instant claims. It is unclear why these applications and patents were cited because they do not appear to be "material to patentability" of the claimed invention (37 CFR 1.56).

MPEP § 2004, particularly § (13), sets forth guidelines to aid applicants in their duty of disclosure. In this section it is stated "It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. See Penn Yan Boats, Inc. v. Sea Lark Boats, Inc., 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1971), aff'd, 479 F. 2d 1388, 178 USPQ 577 (5th Cir. 1973), cert. denied, 414 U.S. 874 (1974)."

are requested to specify why each of the above noted applications or patents were cited. Note applicants' 1449.

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3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki 6,335,137 in view of Aoki et al. and Tavernier et al. Suzuki et al. teaches an electrophotographic toner having a binder colorant and release agent and that when the toner is subjected to various physical conditions such as being pressed as a layer, it will have the same surface coefficient of static friction as applicant as the amount of release agent is within the range of applicant. It is further noted that Suzuki et al. also uses combinations of polyester resins and other specific resins (note column 8 lines 20-45). The use of wax with a variation resin binder is also taught by Aoki et al. who utilizes linear non-linear polyester

lines 20-25 within the range of applicant. Tavernier et al. also teaches a mixture of polymer in a binder with wax.

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agent such as wax in providing a toner utilized in developing latent electrostatic images with a heat fixing step. Applicant's attention is directed to column 7 where a linear polyester is taught (lines 25-30) and a branched cross-link resin (note column 9 lines 25-30). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention with a reasonable expectation of success to utilize known binder combinations with the release agent in providing a toner for the development of latent electrostatic images.

J. Goodrow:cdc

(703) 308-0661

April 29, 2003

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JOHN GOODROW
PRIMARY EXAMINER
APR 29 2003